

PATENT
Customer No. 22,852
Attorney Docket No. 06502.0110-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
James H. WALDO et al.) Group Art Unit: 2142
Application No.: 09/755,084) Examiner: Benjamin A. Ailes
Filed: January 8, 2001)
For: DYNAMIC LOOKUP SERVICE IN) Confirmation No.: 6895
A DISTRIBUTED SYSTEM)

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated March 6, 2006, the Examiner required restriction under 35 U.S.C. § 121 between the following groups of claims:

- Group I Claims 8-11, 22 and 26-29, "drawn to lookup service maintenance," which the Examiner classifies in class 707, subclass 1; and
- Group II Claims 12-21, 23-24 and 30-39, "drawn to client notification of an update," which the Examiner classifies in class 709, subclass 206.

Applicants provisionally elect to prosecute Group I, claims 8-11, 22 and 26-29, with traverse. However, Applicants respectfully traverse the restriction requirement because examination of both the claims of Group I and the claims of Group II in the present application would not present a serious burden on the Examiner.

The Examiner asserts that the inventions of Group II have separate utility “as a notification mechanism that can be used by clients when a lookup service is updated” (see Restriction Requirement, p. 2, ll. 18-20). However, “[t]here must be a *serious* burden on the examiner if restriction is required.” M.P.E.P. § 803 (8th Ed., Aug. 2001) (emphasis added). Applicants respectfully submit that the examination of the claims of Groups I and II in a single application would not present such a “serious burden” on the Examiner.

Both Group I and Group II include claims directed to: a “method in a data processing system having a lookup service with associated services” (*compare* Claim 8 *with* Claim 12); a “data processing system comprising: a memory containing . . . a lookup service[;] . . . [a] client[;] . . . and at least one processor” (*compare* Claim 22 *with* Claim 23); and “a computer-readable medium containing instructions for controlling a data processing system, the data processing system having a lookup service with associated services” (*compare* Claim 26 *with* Claim 30). Accordingly, Applicants respectfully submit that a proper search for the subject matter of Group I would reasonably include at least some of the subject matter of Group II, and vice-versa. This overlap between the searches demonstrates the lack of a serious burden on the Office to consider both the claims of Group I and the claims of Group II in the present application.

Moreover, the claims of both Groups I and II were previously searched and examined in no less than *four* Office Actions on the merits in the present application. *See Office Action (July 7, 2003); Final Office Action (May 7, 2004); Office Action*

(Sept. 27, 2004); and *Office Action* (June 28, 2005). This history of examination of both the claims of both Groups I and II in the same application further demonstrates the lack of a serious burden on the Examiner to consider the claims of both groups in the present application.

“If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to distinct or independent inventions.” M.P.E.P. § 803 (8th Ed., Aug. 2001) (emphasis added). As explained above, the Examiner has not shown that the examination of the claims of both groups cannot be made without “serious burden.” Accordingly, the Examiner *must* examine all of the pending claims on their merits in the present application. *Id.*

For at least these reasons, Applicants respectfully submit that the restriction requirement between Groups I and II is improper. Accordingly, Applicants respectfully request that the requirement for restriction be withdrawn and that all of the pending claims be examined on their merits in the present application.

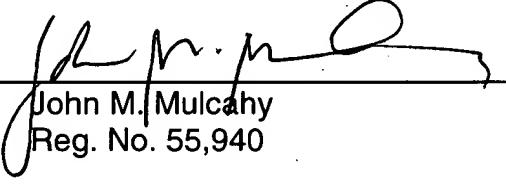
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Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 6, 2006

By: 

John M. Mulcahy
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